



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

07/310,252 02/13/89 QUEEN

C 118239

EXAMINER

FEISEE, L

ART UNIT PAPER NUMBER

186

10

DATE MAILED:

03/05/91

WILLIAM M. SMITH
TOWNSEND AND TOWNSEND
STEUART STREET TOWER
ONE MARKET PLAZA
SAN FRANCISCO, CA 94105

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ^{restricted} ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 9 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-28 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☐ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-6, 8-11, 17-23 are subject to restriction ~~or election~~ requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Serial No. 310252
Art Unit 186

An election was made on paper number 6 filed on 5/26/90 electing group I which consisted of claims 1-6, 8-11 and 17-23. However, the examiner deemed it necessary to further restrict the elected group into the following groups.

5 A telephone call was made to William Smith, on 2/28/91, to request an oral election to the further restriction requirement, but did not result in an election being made as the applicant prefers to receive all requirements in writing.

Restriction to one of the following inventions is required
10 under 35 U.S.C. 121:

I. Claims 1-6, drawn to a method of preparing humanized antibodies, classified in Class 435, subclass 69.6.

15 II. Claims 8-11, drawn to a second method of preparing a humanized antibody, classified in Class 435, subclass 69.6.

III. Claims 17-23, drawn to a method of improving the affinity of a humanized immunoglobulin, classified in Class 435, subclass 69.6.

20 The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are two distinct methods of making a humanized antibody incorporating different steps in each method. Therefore, inventions I and II are subject ^{to} ~~of~~ restriction.

25 Inventions (I and II) and III are distinct methods in that inventions I and II are methods of making a humanized antibody


Serial No. 310252
Art Unit 186

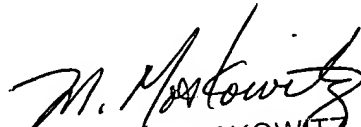
while invention III is a method of improving the affinity of a humanized antibody. Due to the different steps involved in the methods, the three inventions are subject to restriction requirement.

5 Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must
10 be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lila Feisee whose telephone number is (703) 308-2731.

15 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Feisee/lf 
February 28, 1991


MARGARET MOSKOWITZ
SUPERVISORY
PATENT EXAMINER
ART UNIT 186